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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,669	08/30/2000	Loren L Roy	17761-000950US	2031
20350	7590	12/04/2003	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			PEFFLEY, MICHAEL F	
TWO EMBARCADERO CENTER			ART UNIT	PAPER NUMBER
EIGHTH FLOOR			3739	
SAN FRANCISCO, CA 94111-3834			DATE MAILED: 12/04/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

(1)

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/651,669	ROY ET AL.
	Examiner	Art Unit
	Michael Peffley	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 17 November 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 19-27 and 35-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 47-49 is/are allowed.
- 6) Claim(s) 19-22,24-27,35-39 and 42-46 is/are rejected.
- 7) Claim(s) 23,40 and 41 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachments(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

Applicant's amendments and comments, received November 17, 2003 and October 20, 2003, have been fully considered by the examiner. The following is a complete response to the aforementioned communications.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claims 19-22, 24-27, 35-39 and 42-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggers et al ('581).

Eggers et al disclose an electrosurgical device for the treatment of uterine tissue (col. 3, lines 30-35; col. 5). The device includes a thin, flat, rigid surface for contacting tissue, and a plurality of bipolar electrode pairs for delivering energy to tissue (Figure 25A). Eggers et al further disclose a conduit for the delivery of a fluid. Eggers et al disclose that the length of the treatment section may be between 2 and 20mm, and the width in a range from 2 to 10 mm (col. 23, lines 1-22). Also, the device has a maximum height of 4.0mm and preferably less than 1mm. As such, the diameters of the individual electrodes (416) must be less than these values and fall within the range of radius of curvature now set forth in the claims. It is noted that the electrodes (416) protrude from the probe and have a rounded surface as clearly seen in Figure 25A. The electrodes are independently controlled such that peripheral electrodes may be energized independently.

It is noted that the claims recite many intended use limitations. With regard to the Eggers et al system, the examiner maintains that the use of the Eggers et al device

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for ablation is immaterial to the rejection, and it is pointed out that Eggers et al specifically disclose the device as also being used to contract or shrink tissue (col. 27, line 10). The Eggers et al device is inherently capable of performing the intended uses set forth in the claim language, and the claims fail to define structural limitations which define over the Eggers et al system.

***Allowable Subject Matter***

Claims 23, 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 47-49 are allowable over the prior art of record.

***Response to Arguments***

Applicant's arguments filed October 20, 2003 have been fully considered but they are not persuasive.

Applicant contends that the examiner is incorrect for asserting that the Eggers et al electrodes (416) are rounded, and continues to state that the electrodes have a "u" shaped configuration. The examiner agrees that the Eggers et al electrodes are "u" shaped, but maintains that such a shape is clearly rounded (i.e. at the bottom). The claims as amended fail to define the direction of the rounded portion. The language merely requires a rounded protruding element having a radius of curvature and engageable against the target region. The examiner maintains that the Eggers et al electrode meets this language, regardless of whether or not it is in the same orientation as the applicant's disclosed electrodes. Again, as seen in Figure 25A, each electrode

(416) protrudes from the probe, is rounded (i.e. at the bottom of the protrusion) and is engageable against tissue.

Applicant additionally argues that the Eggers et al device is not a static probe. The examiner asserts that this is not a structural limitation, but rather an intended use of the device. If the Eggers et al probe were introduced to tissue and held in place, it would constitute a static probe and would still function to deliver energy to tissue. That Eggers et al teach that the device is preferably moved during tissue treatment does not mean it can not function as a static probe is so desired.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

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December 2, 2003